

REMARKS

The claims are 38-157. Applicants would like to thank Examiner Huang for the helpful and courteous interview held May 28, 2002. The substance of the interview is summarized below.

Interference number 104,751 has been terminated by an award of priority in favor of Applicants.¹ Subsequently, a rejection under 35 U.S.C. §112 was issued, to which the above amendment responds. As discussed during the interview, the only independent claim, Claim 38, now recites the chemical formula for the silicone oil found at specification page 3. As agreed, this amendment addresses the §112 rejection and, as all remaining claims are dependent claims, places this application in condition for allowance.

As discussed at the interview, foreign patent applications related to the present application have been the subject of Opposition proceedings in Europe and Japan. Information regarding these Oppositions has been provided in the Information Disclosure Statement filed with this response. However, during the interview several of the references applied in these foreign actions were reviewed and discussed, and it was shown that these references failed to present a *prima facie* case against the claims pending in this application, as no reference discloses or suggests the particular combination of silicon oil and wax as presently claimed, or the ability of this particular combination to produce a broad range of silicon oil-based anhydrous compositions without being limited by a restrictive range of proportions, without the need for a co-solvent, etc. As the review during the Interview of the several cited references showed, Applicants have discovered both a novel and unobvious

¹A copy of the Board's Judgment and Recommendation and a copy of Judge Tierney's communication of October 24, 2000 are attached.

combination of components that is both practical and useful, and that is patentable over the prior art.

As the Examiner will note, the newly-presented claims are directed to the subject matter defined by the count of the interference, which subject matter was previously found by the examiner to be patentable over the prior art. Since the concerns expressed by both Examiner Huang and Judge Tierney have been addressed by the presentation of the new claims, Applicants believe that the application is now in condition for allowance, and respectfully request prompt consideration and allowance of the application.

During the interview Examiner Huang raised the issue of obviousness-type double patenting over the two parent patents. While Applicants disagree that there is an obviousness-type double patenting issue, Applicants have nevertheless attached hereto a Terminal Disclaimer over the two parent patents. Thus, any issue regarding double patenting has been addressed.

Finally, during the interview Applicants explained that they would be adding several dependent claims, which they have done. Several of these claims are supported in the specification by reference to a trade name, for example "DC 556" at specification page 4, line 12. This commercially-available silicone oil is identified by its chemical name phenyl trimethicone, which appears in several dependent claims (for example, dependent claim 45, dependent claim 49, dependent claim 50, etc.) The specification has been amended to provide literal support for such claims, and these amendments are supported by reference to the various trade brochures, etc. describing these materials. These brochures are attached hereto for the Examiner's convenience and explained in detail below. The remainder of this response simply points out support for the several dependent claims added above, and provides a Summary for the Examiner's convenience.

Before closing, Applicants would again like to thank Examiner Huang for granting the May 28, 2002 interview, and for her willingness to review at the interview the several references noted in the Interview Summary Record and cited during foreign patent office proceedings. As discussed during the interview and noted above, Applicants' claims distinguish over this art and define an invention deserving of patent protection in the United States. Early notification to this effect would be greatly appreciated.

SUPPORT FOR AMENDMENTS

Specification pages 4 and 5 have been amended to identify specific silicone fluids and specific hydrocarbon waxes that are identified in the original specification by names used in trade. Thus, "DC 556" is identified by its chemical name phenyl trimethicone by reference to the Dow brochure for this product and the excerpt from the International Cosmetic Ingredient Dictionary and Handbook, Eighth Edition, Vol. 2, pages 1081 (1999) (Hereinafter "Handbook") for this material. "Silbione 70633 B 30" is identified by its chemical name, bisphenyl hexamethicone, by referral to U.S. 5,744,130 (col. 19, lines 54-56) and the Handbook excerpt describing this material (pages 151-152). As the structural formulas are clearly given in the cited materials, the relationship to the general structural formula (I) has also been indicated. It is noted that the Stepniewski Patent 5,648,066, the patent of the opposing party in the interference, also identifies DC 556 as phenyl trimethicone in its example 2.

Similarly, specification at page 7 has been amended to identify the hydrocarbon waxes "Polywax 500," "Polywax 655", and "Polywax 1000." The identifications are taken from the attached Bareco trade brochure.

In addition to the support for the specification amendments, new Claims 38-157 are supported at specification pages 3-4, page 5, page 6 (bottom), page 7, 8-9, 10 and by the Examples and original claims. Because the lines of the original specification are not numbered, reference may also be made to parent patent 5,556,613 at column 1, line 61- column 2, line 33, column 2, lines 34-42, the paragraph bridging columns 2-3, column 3, line 3, lines 10-18, 22-25, 36 ff and 65-67, column 4, lines 1-30, 40-53 ff, column 5, lines 1-3 and the Examples.

SUMMARY

The patentability of claims 38-157 over the prior art is apparent from the allowance of Applicants' parent Patents 5,750,095 and 5,556,613, as well as the patentability of claims 13-37 over the prior art as recognized by the allowance of those claims in the application leading to the interference. Claims 13-37 were, of course, broader in some respects (i.e., the silicone oils) and narrower in other respects (i.e., the polyethylene wax) than the claims allowed in the parent patents. While applicant's have filed a Terminal Disclaimer over the two parent patents as requested at the interview, the examiner has previously recognized the separate patentability of claims directed to the subgrouping of polyethylene wax components in granting the Stepniewski patent, and in the previous allowance of Applicants' claims 13-37, and in addition has noted the distinctions between the art cited in the foreign Oppositions over the pending claims. Nevertheless, and in order to gain allowance of the claims, the Terminal Disclaimer is attached.

Accordingly, and as the present application is now believed to be in condition for allowance, a prompt notice to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to be 'Richard L. Treanor', written over the firm name.

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IN THE SPECIFICATION

(1) At specification page 4, following line 14, insert the following paragraph:

--"DC 556" is phenyl trimethicone, a compound of formula (I) wherein n is 0 and R is methyl. "Silbione 70633 V 30" is bisphenyl hexamethicone. It is a compound of formula (I) wherein R is methyl, n is 0, and m is 2.--

(2) At specification page 5, following line 14, add the following paragraph:

--"Polywax 500", "Polywax 655", and "Polywax 1,000" are homopolymers of ethylene having molecular weights of 500, 700, and 1,000, respectively, as determined by vapor pressure osmometry--

IN THE CLAIMS

--Claims 13-37 (Canceled).

Claims 38-157 (New).--